

REMARKS

The Official Action of March 11, 2004 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 8 has been amended by inserting therein the recitations formerly in claim 21, and the latter claim has been canceled. The dependent claims have been amended to take account of the amendment to claim 8. New claims 34 and 35 have been added more completely to define the subject matter which Applicants regard as their invention. The recitations in new claim 34 draw support from the specification as filed at, for example, page 16, lines 16-18 (amount of the pigment); page 26, lines 5-8 (amount of the organic solvent); page 14, lines 14-20 (amount of the fine particles) and page 30, lines 32-35 and the Examples (amount of the solid wetting agent- -see discussion below). The recitations in new claim 35 draw support from the specification as filed in the paragraph bridging pages 29 and 30.

The amendments to the claims have been taken so that the claims correspond with the Examples in the specification, which show that the exemplified ink compositions which comprise both a polymer emulsion prepared by the recited process and a solid wetting agent are superior to the ink compositions in which the solid wetting agent is missing or the polymer emulsion is prepared by a different process. In particular, Table B2 on page 64 of the specification shows the results of the evaluations B1-B7 (the evaluations are described in the specification at pages 60-

63) for each of the ink compositions of Examples B1-B8 and Comparative Examples B1-B4 (these ink compositions are described in the specification at Table B1 on page 59).

The results set forth in Table B2 on page 64 of the specification show that the ink compositions of Examples B1 to B6 are superior to the ink compositions of Examples B7 and B8 and Comparative Examples B1-B4 in two or more of the evaluations. As shown in Table B1, the ink compositions of Examples B7 and B8 contain the polymer emulsion produced by the recited process but lack a solid wetting agent such as Maltitol or Xylitol. As shown in Table B2, these two ink compositions were inferior to the claimed ink composition with respect to Evaluation B2 (anti-clogging property) and Evaluation B6 (storage stability). Moreover, the ink compositions of Comparative Examples B1-B4 contain the solid wetting agent with polymer emulsions that were produced by processes other than the process defined in the claims (compare Polymer emulsions B1-B6 (specification at pages 45-51) with Polymer emulsions B7-B10 (specification at pages 51-54)). As shown in Table B2, the four comparative ink compositions were inferior to the claimed ink composition in most of the evaluation tests.

The claims stand rejected as allegedly being anticipated under 35 USC 102(e) or as allegedly being unpatentable under 35 USC 103(a) in view of the references and combinations of references cited at paragraphs 6-11 of the Official Action. However, it is respectfully noted that the only rejection that has been applied against the

recitations of claim 21, which recitations have now been incorporated into the main claim, is the rejection under 35 USC 103(a) for alleged unpatentability over Freeman et al or Ganapathiappan in view of Ohta et al. Applicants respectfully traverse this rejection.

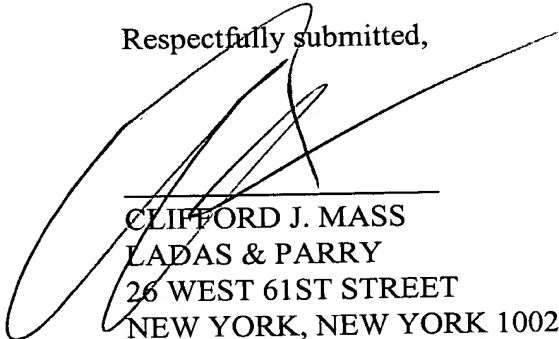
The Examiner has acknowledged that neither Freeman or Ganapathiappan disclose an ink composition comprising a solid wetting agent, but contends that there would have been a motivation to combine the saccharide disclosed by Ohta et al with the ink compositions described by Freeman or Ganapathiappan. Even assuming for the sake of argument that this were true and that the references were sufficient to set forth a *prima facie* case of alleged obviousness for the invention as now claimed, it is respectfully submitted that the evidence of record in the specification would be sufficient to rebut such alleged *prima facie* case.

In particular, the results shown in the specification- - that the claimed ink composition is superior to ink compositions wherein the claimed polymer emulsion is not produced by the recited process or which do not contain the claimed solid wetting agent (see discussion above)- - could not have been expected from the cited references. The primary references already provide humectants to impart moisture retention (see Freeman et al at paragraphs 0032 and 0033, and see Ganapathiappan examples), and there would have been no reason to believe that a solid wetting agent would improve the compositions with respect to any of the evaluation criteria tested. Indeed, each of the cited primary references were filed after the publication of the

Ohta et al reference and would have taught the inclusion of a solid wetting agent if the advantageous effects of doing so could have been expected.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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